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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,671	03/29/2004	Veronika Hochstein	MERCK-2867	1160

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EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,671

Applicant(s)

HOCHSTEIN ET AL.

Examiner

C. Melissa Koslow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/22/05, 1/25/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

This action is in response to applicants' amendment of 25 January 2006 and the arguments of 22 December 2005. Upon reconsideration of the art, the 35 USC 102 rejection over U.S. patent 6,517,628; the 35 USC 102 rejection of claims 2-9 and 11-13 over WO 02/90448; the 35 USC 102 rejection of claims 2-9, 12 and 13 over WO 03/6558 and the obviousness-type double patent rejection over claims 5-9 and 13 are all withdrawn. Applicants' arguments with respect to the remaining previous rejections have been fully considered but they are not persuasive.

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The added proviso is new matter. There is no explicit disclosure of the proviso, no explicit disclosure of a glass flake containing alternating layers of TiO₂, SiO₂ and TiO₂ and *Ex parte Parks*, 30 (USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) is not applicable. See MPEP 2173.05(i).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 10-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8, 11 and 13-19 of U.S. Patent No. 6,517,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pigment mixture claimed in the patent includes the claimed pigment mixture. The patented mixture comprises component B, which can be the B pigments claimed in this application and component A, which can have a glass substrate. The glass substrate based A pigments reads upon the A pigments of this application. The patented claims teach a cosmetic and a food product comprises the patented pigment mixture. This suggests the composition of claims 11 and 12 of this application. The patented weight ratio of A to B falls within the claimed range.

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Applicants' arguments are not convincing. The arguments with respect to the 102 rejection are not applicable since this rejection is based on obviousness, not anticipation. Claim 1 of the patent clearly teaches component A can be a glass flake coated with two or more layers including at least one layer of high refractive index adjacent to at least one layer of low refractive index, i.e. an effect pigment based on glass flakes, since the glass flake substrate is one of the species in the patented Markush group. Thus the patented claims do make obvious the claimed mixture.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/90448.

Page 6, line 33 through page 7, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment and inorganic crystalline pigments, which are different from the taught glass based pigments. It is clear from the rest of the reference that the glass flake does not contain alternating layers of TiO_2 , SiO_2 and TiO_2 . The reference clearly teaches the claimed mixture.

Applicants' arguments are not convincing. The rejected claim is not directed to any specific mixture. *In re Kollmanis* is not applicable since the fact pattern in that case is different from the facts in this application. The teaching in the paragraph on pages 6-7 of mixtures is a clear direction to make the disclosed mixtures. The fact there are no examples containing mixtures does not negate the rejection. A reference is not limited to working examples. *In re Fracalossi* 215 USPQ 569 (CCPA 1982). The rejection is maintained.

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Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 03/6558.

Page 14, line 31 through page 15, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment and inorganic crystalline pigments, which are different from the taught glass based pigments. While one embodiment contains alternating layers of TiO_2 , SiO_2 and TiO_2 , the other embodiments on pages 9 and 10 do not. Example Use 1 teaches a cosmetic comprising at least one cosmetically suitable additive, a glass based effect pigment, three flake form pigment and a flake form filler. The reference clearly teaches the claimed mixture and cosmetic composition.

Applicants' arguments are not convincing. With respect to the argued excluded embodiment, this embodiment is not exclude in the composition of claim 11. Applicants argument that the other embodiments on pages 9 and 10 are broad generic teachings is not convincing since specific layer compositions are stated. The teaching in the paragraph on pages 14-15 of mixtures is a clear direction to make the disclosed mixtures. *In re Kollmanis* not applicable since the fact pattern in that case is different from the facts in this application. The rejection is maintained.

NEW REJECTIONS

Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-11340; pages 2, 8, 10 and 14 of the 2002 Engelhard submission, the page titled "SMOKES & SPARKLES" and the page titled "CHAMELEON".

The examples of page 12-14, 17 and 18 of the translation of JP 2001-11340 and the submitted pages all teach cosmetics comprising cosmetically suitable additives, a glass based

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effect pigment and at least one addition pigment, such as mica, iron oxide, titanium dioxide, organic pigments and multilayer pigments. The taught cosmetics all clearly read upon the claimed cosmetic.

U.S. patent 6,875,264 and U.S. patent application publication 2005/220741 are cited as of interest since they teach the Reflecks pigment in the pages 2, 8, 10 and 14 of the 2002 Engelhard submission, the page titled "SMOKES & SPARKLES" and the page titled "CHAMELEON" ate glass based effect pigments.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/90448.

Page 6, line 33 through page 7, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment and inorganic crystalline pigments, which are different from the taught glass based pigments. It is clear from the rest of the reference that the glass flake does not contain alternating layers of TiO_2 , SiO_2 and TiO_2 . One of ordinary skill in the art would have found it obvious to use any of the specified pigments on pages 4-6 as the pigment which is blended with the listed pigments on page 6, line 33 through page 7, line 2, such as the disclosed luster, or interference, pigments, which are multi-layered pigments. This list includes the claimed pigments of glass flake+ TiO_2 layer, glass flake+ Fe_2O_3 layer, glass flake+ Fe_3O_4 layer, glass flake+ TiFe_2O_3 layer and glass flake+ Cr_2O_3 layer. The weight ratio of the suggested blend is greater than 0: less than 100 to less than 100:greater than 0. This range encompasses the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA

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1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The taught glass flakes have a thickness of 0.1-0.5 micron, which falls within the claimed range. Page 7, lines 4-6 and page 8, lines 1-9 teach the pigment mixtures can contain wetting agents, dispersing agents, water and at least one organic solvent. All of these compounds are additives which are conventional in cosmetics. The reference suggests the claimed pigment mixture.

The arguments over the rejection are not convincing. Applicants argue there are no taught embodiments in the reference that fall within the scope of the instant claims. Applicants are correct and that is why this rejection based on 35 U.S.C. 103(a), not 35 U.S.C. 102, which requires the taught embodiments in the reference that fall within the scope of the instant claims. The rejection is maintained.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/6554.

Page 14, line 31 through page 15, line 2 of this reference teaches a mixture of an effect pigment based on glass flakes and any of the listed pigments, which includes inorganic flake form pigment and inorganic crystalline pigments, which are different from the taught glass based pigments. One of ordinary skill in the art would have found it obvious to use any of the specified pigments on pages 9-10 as the pigment which is blended with the listed pigments on page 14, line 31 through page 15, line 2, such as the disclosed luster, or interference, pigments, which are multi-layered pigments. This list on page 9-10 includes several of the claimed pigments. The weight ratio of the suggested blend is greater than 0: less than 100 to less than 100:greater than 0. This range encompasses the claimed range. Product claims with numerical ranges which overlap

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prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). The taught glass flakes have a thickness of 0.1-0.8 micron, which falls within the claimed range. Page 15, lines 9-12 teach the pigment mixtures can contain wetting agents, dispersing agents, water and at least one organic solvent. All of these compounds are additives which are conventional in cosmetics. The reference suggests the claimed pigment mixture.

The arguments over the rejection are not convincing. Applicants argue there are no taught embodiments in the reference that fall within the scope of the instant claims. Applicants are correct and that is why this rejection based on 35 U.S.C. 103(a), not 35 U.S.C. 102, which requires the taught embodiments in the reference that fall within the scope of the instant claims. The rejection is maintained.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,517,628.

This reference teaches a pigment mixture and the use of this mixture to color cosmetics and medicament coatings (col. 3, lines 50-53). Thus the reference teaches cosmetics containing the pigment mixture and at least one cosmetically suitable additive, a pharmaceutical composition comprising the pigment mixture and at least one pharmaceutical medicament. Column 3, lines 50-53 also using the pigment mixture as a food coloring, which means it would have been obvious to use it in the same applications, as conventional food colorings, such as in icings. Thus the claimed food finishing composition is suggested. The pigment mixture comprises component A, which is a multilayered effect pigment where the substrate can be glass

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flakes and component B, which comprise flaky, acicular or spherical colorants and/or fillers. The weight ratio of A to B is 1:10 to 10:1, which falls within the claimed range. Column 2, lines 30-35 teach the preferred layer structure of the pigment of component A. When the substrate is a glass flake, then several of the pigments of claims 3 and 4 are suggested. The thickness of the substrate of component A is 0.4-2 microns, which overlaps the claimed range. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Column 3, lines 4-24 and 30-35 teaches the pigment of the B component is a pearlescent/interference pigment, a multilayered OVP pigment or a holographic pigment. Example 4 and 7 show that the taught pigment mixture can also contain at least one additive which is conventional in cosmetics. The reference suggests the claimed pigment mixture, cosmetic, food finishing composition and pharmaceutical composition.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmk
May 19, 2006



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